



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,865	03/06/2002	Marie-Claude Meyer	P-5620DIV	7881

28465 7590 10/04/2004

PIPER RUDNICK  
P. O. BOX 64807  
CHICAGO, IL 60664-0807

EXAMINER

HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
----------	--------------

1754

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SC

# Office Action Summary

Application No. 121091865	Applicant(s) Meyer
Examiner Hickman	Group Art Unit 1754

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 15-24 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 15-24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 36102
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

\*Claims 25-28 are not in proper form. MJP 114  
MJP

Art Unit: 1754

-The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) In claim 15, 'highest ... when it is basic' is unclear if the material is strongly acid and what the process is with the assigned pK. Normally, pKa refers to dissociation of a proton and conventional form is to portray a material in its most protonated state, with successive pKs to denote successive deprotonation.

B) In claim 15, 'at least a couple' is unclear if more than two are meant. If a coupled system of reagents (sodium carbonate/sodium bicarbonate, etc.) is meant then it appears that 'at least' is unnecessary, given that the claim recites 'comprising'. It appears that 'a composition comprising an acid material and its conjugate anion...' or the like is intended.

C) Claim 21 is unclear as to how many of the 4 chemicals are selected, and further appears to have the couples mixed. It is not clear from the claim if one can choose both sodium carbonate and sodium bicarbonate.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1754

Claims 15-20 and 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6380130. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented composition appears to fall within the guidelines of the claims, and conversely choosing two particular known reagents having the claimed properties/relationship is an obvious expedient to form the desired composition.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. 5342543.

Morris teaches in column 3 and 4 sodium bicarbonate, sodium carbonate and a color indicator which changes color around pH 7. Thus, this indicator takes up or loses protons so as to change its structure (if it did not, it would not function as a pH indicator). Therefore, it has a pK of around 7. Further is an (oil soluble) adsorbent polymer. Because sodium carbonate and bicarbonate are known sorbents (refrigerator odors, carpet odors, etc.) they also serve as a water-soluble sorbent. There is no requirement that the water soluble adsorbent be a different material from those already recited. The reference differs in that does not require/explicitly disclose the claimed ingredients explicitly, however choosing the claimed materials from those disclosed by the reference is a matter of obvious optimization to make an adsorbent; In re Boesch 205 USPQ 215.

Art Unit: 1754

Claims 15-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumoto et al. 5409769.

The reference teaches in columns 3-4 compositions including active carbon (oil soluble sorbent), water soluble sorbents, phosphoric acid (having 3 pKas ranging from about 4 to 7) and an amino acid. The reference does not require the claimed ingredients explicitly, however choosing the claimed materials from those disclosed by the reference is a matter of obvious optimization to make an adsorbent; In re Boesch 205 USPQ 215.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', is positioned above the printed name.

Stuart Hendrickson  
examiner Art Unit 1754